

### **REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1-2, 4-6, 10-12, 17, 25-26, 28-30, 34-36, 41, and 50-51 have been amended. No new matter has been added. Claims 18-22 and 42-46 were previously withdrawn. Thus, claims 1-18, 23-41, and 47-53 are currently pending in the application and subject to examination.

In the Office Action mailed June 26, 2006, the Examiner rejected claims 1-2, 4-11, 23-26, 28-35, and 47-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,298,441 to Handelman et al. ("Handelman") in view of U.S. Patent No. 6,195,667 to Duga et al. ("Duga"). The Examiner rejected claims 50-51 under 35 U.S.C. § 102(e) as being anticipated by Handelman in view of Duga. The Examiner rejected claims 52-53 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,415,316 to Van Der Meer ("Van Der Meer") in view of Duga. The Examiner rejected claims 3, 12-17, 27, 36-41 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Handelman in view of Duga and further in view of U.S. Patent No. 6,675,384 to Block et al. ("Block"). It is noted that claims 1-2, 4-6, 10-12, 17, 25-26, 28-30, 34-36, 41, and 50-51 have been amended. To the extent that the rejections remain applicable to the claims currently pending, the Applicant hereby traverses the rejection, as follows.

#### **Claims 1-9 and 25-33**

Applicant's invention as now set forth in amended claim 1 is directed to a method for restricting access to electronic books displayed on a viewer including, in part, receiving identification information from a user; and receiving information on whether

the electronic book contains a restriction based on content, a rating, an associated access level, a page order restriction, a time based restriction, and, if the electronic book contains at least one restriction, on whether the restriction applies to the identified user.

This allows the display of an electronic book to be restricted in multiple ways, and for each type of restriction, information is received regarding whether or not the electronic book contains the particular type of restriction.

Handelman teaches an electronic book which has a type of parental control, where access to certain electronic books is restricted unless a parent smart card is inserted into the electronic book. However, Handelman does not disclose or suggest at least receiving information on whether the electronic book contains a restriction based on content, a rating, an associated access level, a page order restriction, a time based restriction, and, if the electronic book contains at least one restriction, on whether the restriction applies to the identified user.

Duga, Van Der Meer, and Block fail to cure the deficiency in Handelman.

For at least this reason, the Applicant submits that claim 1 is allowable over the cited art. For similar reasons, the Applicant submits that claim 25 is likewise allowable. As claims 1 and 25 are allowable, the Applicant submits that claims 2-9 and 26-33, which depend from allowable claims 1 and 25, are also allowable for at least the reasons noted above and for the additional limitations they provide.

Claims 10-17, 34-41, and 50-51

Applicant's invention as now set forth in amended claim 10 is directed to a method for restricting access to electronic books displayed on a viewer, including

receiving a restriction on selected content from a user, wherein the user selected content includes at least one of an image, text, a page, and a section of an electronic book; saving a first restricted version of the electronic book in the library unit including the original format of the electronic book; creating a second, unrestricted version of the electronic book by deleting the user selected content; and saving the second unrestricted version of the electronic book in the library unit.

Handelman teaches an electronic book viewer that receives a document in several versions, wherein parents can control which version of the document may be displayed. However, Handelman does not teach an unrestricted version created at the user's library unit by deleting user selected content, which was selected to create a first, restricted version.

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For at least this reason, the Applicant submits that claim 10, as amended, is allowable over the cited art. For similar reasons, the Applicant submits that claims 12, 17, 34, 36, 41, 50, and 51 are likewise allowable. As claims 10, 12, 17, 34, 36, 41, 50, and 51 are allowable, the Applicant submits that claims 11, 13-16, 35, and 37-40, which depend from allowable claims 10, 12, 17, 34, 36, 41, 50, and 51, are also allowable for at least the reasons noted above and for the additional limitations they provide.

Claims 23-24, 47-49, 52, and 53

Applicant's invention as set forth in claim 23 is directed to a method for controlling access to an electronic book displayed on a viewer, including, in part, receiving information relating to a viewer mode for displaying the electronic book on the

viewer; and restricting access to a content of the electronic book based upon the viewer mode.

This allows a certain mode of display to be defined for the electronic books. As discussed in the specification, a few embodiments of such a viewer mode restriction are requiring the pages of the book to be displayed in order, or requiring a predetermined time period to pass before the viewer will change to the next page of the electronic book. This also allows a book to require the correct input of an answer to a question on the presently displayed page before displaying the next page, or any other restriction on the "mode" of display. Such features enhance textbooks or other education based books that may be used on the electronic book viewer.

In the Office Action, the Examiner asserted that Handelman teaches receiving information relating to a viewer mode because Handelman receives information indicating if the user purchased the electronic book and limits access to certain versions of the electronic book. The Applicant asserts that both receiving information indicating if the user purchased the electronic book and limiting access to certain versions of the electronic book are merely limitations on access. These pieces of information determine whether or not a document will be displayed, they do not control the "viewer mode" for display, as claimed in claim 23.

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For at least this reason, the Applicant submits that claim 23 is allowable over the cited art. For similar reasons, the Applicant submits that claims 47, 52, and 53 are likewise allowable. As claims 23 and 47 are allowable, the Applicant submits that claims 24, 48, and 49, which depend from allowable claims 23 and 47, are also

allowable for at least the reasons noted above and for the additional limitations they provide.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 3. This is an insufficient showing of motivation.

### **CONCLUSION**

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, with reference to Attorney Docket No. 026680-00029.

Respectfully submitted,

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